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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,728	09/14/2000	Dimitri Kanevsky	728-172	9029
7590 02/24/2005				
Paul J Farrell Esq Dilworth & Barrese 333 Earle Ovington Boulevard Uniondale, NY 11553			EXAMINER WALLERSON, MARK E	
			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/661,728	Applicant(s) KANEVSKY ET AL.	
	Examiner Mark E. Wallerson	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 18-29, 40-52, 63-81 and 83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11, 15-17, 30-32, 36, 38, 39, 53-55, 60-62 and 82 is/are rejected.
- 7) ☐ Claim(s) 12-14, 33-35, 37 and 56-59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/14/2000</u> . | 6) <input type="checkbox"/> Other: _____ |

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: the election of claims filed on 10/7/04.

2. This application has been reconsidered. Claims 1-83 are pending. Applicant has elected claims 1-17, 30-39, 53-62, and 82. These are the only claims being examined in this Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 30, 36, 39, 53, and 62, are rejected under 35 U.S.C. 102(b) as being anticipated by Woods (U.S. 5,280,430).

With respect to claims 30 and 53, Woods discloses receiving information concerning a printer (column 3, lines 33-50), receiving user instructions concerning a real-time transcription (column 3, lines 33-40 and column 5, lines 12-30), receiving transcribed text from a transcription service (column 6, lines 1-9), translating the text into a format compatible with the printer (column 6, lines 1-9) and maintaining an active connection with the printer (column 5, lines 33-55).

With regard to claim 36, Woods discloses a means for buffering the transcribed text into fragments (separate files) and sending the fragments to the printer (column 8, lines 19-42).

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With regard to claims 39 and 62, Woods discloses a GUI (32) allowing a user to input control parameters concerning real-time transcription (column 5, lines 20-27).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 31, 32, 38, 54, 55, 60, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woods in view of Padmanabhan (U.S. 6,219,638).

With regard to claims 31, 32, 54, and 55, Woods differs from claims 31, 32, 54, and 55 in that he does not clearly disclose integrating video, images, or graphics into the text.

Padmanabhan discloses a messaging system wherein multimedia signals are integrated with text (column 1, lines 20-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods to disclose integrate video, images, or graphics into the text. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods by the teaching of Padmanabhan in order to give the user different options for data to be transmitted.

With respect to claims 38, 60, and 61, Padmanabhan discloses means (PDA) for displaying the video signal (column 1, lines 19-36) and a speaker for playing the audio signal (column 1, lines 20-40).

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 3, 5, 6, 7, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woods et al (Woods) (U.S. 5,280,430) in view of Schrage (U.S. 6,850,609).

With respect to claims 1 and 10, Woods discloses a transcription system (figure 2) comprising a printing means (16); a transcription service (18) for producing transcribed text (column 6, lines 1-9), and a real-time translation computer (14) (column 5, lines 12-30), wherein the computer receives transcribed text from the transcription service (13) and translates it into a format compatible with the printing means (column 6, lines 1-9).

With regard to claim 2, Woods differs from claim 2 in that he does not clearly disclose the printing means is a fax machine. Schrage discloses using a fax machine (14) as the printing means. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods wherein a fax machine is used as the output device. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods by the teaching of Schrage in order to give the user more variety in output devices.

With respect to claim 3, Woods discloses a printer (16).

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With regard to claim 5, Woods discloses a stenograph writer (column 5, lines 15-18) and a processor for translating the data input from the stenograph machine to text (column 6, lines 1-9).

With respect to claim 6, although Woods discloses translating speech (spoken words) into text (the abstract), he does not clearly disclose a microphone and an automatic speech recognition program. Schrage discloses a microphone (audio source) (column 2, lines 47-52) and an automated speech recognition program (column 3, lines 60-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods to include a microphone and an automatic speech recognition program. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods by the teaching of Schrage in order to simply or improve the speech recognition process.

With respect to claims 7 and 11, Woods discloses a module (14) for providing an interface with the transcription service and the printing means; a print connection module (14) for maintaining an active connection with the printer; a means for buffering the transcribed text into fragments (separate files) and sending the fragments to the printer (column 8, lines 19-42), and means for controlling the real-time transcription process for directing signals to the computer, storing user preferences and information of the printer (column 7, lines 15-57).

Woods differs from claim 7 in that he does not clearly disclose that the computer acts as a server.

Schrage discloses a transcription service wherein a transcription server (12) is used to receive and transmit transcriptions from a transcription service (column 7, lines 22-40).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods wherein the computer is used as a server. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods by the teaching of Schrage in order to be able to add different output units to the system.

Woods also differs from claim 7 in that he does not clearly disclose the printing means is a fax machine. Schrage discloses using a fax machine (14) as the printing means. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods wherein a fax machine is used as the output device. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods by the teaching of Schrage in order to give the user more variety in output devices.

With regard to claim 17, Woods discloses a GUI (32) allowing a user to input control parameters concerning real-time transcription (column 5, lines 20-27).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woods in view of Schrage as applied to claim 1 above, and further in view of Lyberg (U.S. 5,752,227).

With respect to claim 4, Woods as modified differs from claim 4 in that he does not clearly disclose the printing means comprises a telex machine. Lyberg discloses a transcription system that utilizes a telex machine as an output device (column 4, lines 26-35). Therefore, it

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would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods as modified wherein a telex machine is used as the output device. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods as modified by the teaching of Lyberg in order to vary the output devices.

11. Claims 8, 9, 15, 16, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woods in view of Schrage as applied to claim 7 above, and further in view of Padmanabhan (U.S. 6,219,638).

With regard to claims 8, 9, and 82, Woods as modified differs from claims 8, 9, and 82 in that he does not clearly disclose integrating video, images, or graphics into the text.

Padmanabhan discloses a messaging system wherein multimedia signals are integrated with text (column 1, lines 20-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods as modified to disclose integrate video, images, or graphics into the text. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Woods as modified by the teaching of Padmanabhan in order to give the user different options for data to be transmitted.

With respect to claims 15 and 16, Padmanabhan discloses means (PDA) for displaying the video signal (column 1, lines 19-36) and a speaker for playing the audio signal (column 1, lines 20-40).

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Allowable Subject Matter

12. Claims 12, 13, 14, 33, 34, 35, 37, 56, 57, 58, and 59, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER

